

REMARKS**Summary of the Office Action**

Claims 6-11 stand rejected under 35 U.S.C. § 112, second Paragraph.

Claim 9 stand objected to under 37 C.F.R. § 1.75(c).

Claims 6-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) being obvious under Newman, *An Illustrated Dictionary of Glass*.

Claims 6, 7, 8, and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Gardner, *The Glass of Frederick Carder*.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardner.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either Newman or Gardner, in view of the Mikron M90 Infared Thermometer data sheet.

Summary of the Response

Applicant proposes amending claim 6, cancelling claims 7-11 without prejudice or disclaimer, and adding new claims 12-15. Based on the arguments presented below, claims 6-15 are pending for further consideration.

35 U.S.C. § 112 2nd Paragraph Rejection

In the Office Action, claims 6-11 stand rejected as being indefinite. Applicant respectfully requests withdrawal of the 35 U.S.C. § 112 2nd Paragraph rejection of claim 6 as amended, and notes that claims 7-11 have been cancelled.

Amendment to the Claims

Applicant respectfully submits that the amended claims do not contain new matter. Namely, the majority of the amendments include matter from the originally presented dependent claims.

Similarly, Applicant respectfully notes that the recitation of enlarging “at least two times” has been amended to enlarging “five to thirty times,” which is supported in original claim 7 and paragraph 12 line 6.

Rejections under 35 U.S.C. § 102(b) and 103(a)

In the Office Action, claims 6-9 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) obvious under Newman, *An Illustrated Dictionary of Glass*. Further, in the Office Action, Claims 6, 7, 8, and 10 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Gardner, *The Glass of Frederick Carder*.

35 U.S.C. 102(b)

Applicant respectfully submits that elements of independent claim 6 as amended are not taught or fairly suggested in either Newman or Gardner. In the Office Action, it is noted that Newman is silent regarding the degree of enlargement. Based upon this silence, Applicant respectfully submits that Newman cannot serve as the basis of a 102(b) rejection. MPEP 2131. (stating, “To anticipate a claim, the Reference must teach every element of the claim.”). As Newman fails to disclose an enlargement of five to thirty times, Applicant respectfully requests withdrawal of the 102(b) rejection.

Similarly, in the Office Action, it is stated that Gardner teaches enlarging at least two times where a 3 inch crystal parison is used to make a 6-8 inch vase. Applicant respectfully submits that an enlargement of two to three times was contemplated by the Applicant in the Background of the Invention, and claim 6 as amended recites a novel enlargement of five to thirty times. Since Gardner fails to teach or fairly suggest an enlargement of five to thirty times, Applicant respectfully requests withdrawal of the 102(b) rejection. “[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.” *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims to titanium (Ti) alloy with 0.8% nickel (Ni) and 0.3%

molybdenum (Mo) were not anticipated by, although they were held obvious over, a graph in a Russian article on Ti-Mo-Ni alloys in which the graph contained an actual data point corresponding to a Ti alloy containing 0.25% Mo and 0.75% Ni.).

35 U.S.C. 103(a)

Applicant respectfully submits the subject matter as a whole would have not been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. As described in the Background of the Invention section of the application, prior intarsia glass or millefiori glass, such as those described by Newman or Gardner, could only be enlarged two or three times. Based on the historical inability to evenly enlarge intarsia/millefiori glass greater than two or three times, Applicant submits that it would not have been obvious for one having ordinary skill in the art at the time the invention was made to attempt to enlarge the glass five to thirty times.

Applicant respectfully submits that neither Newman nor Gardner address enlargement abilities or limitations, and more specifically, neither address an enlargement of five to thirty times. As such, a Prima Facie case of obviousness has not been made. As stated in MPEP 2143, “[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Applicant respectfully submits that even if there were a suggestion or motivation to modify the teachings of Gardner and Newman, there was no reasonable expectation of success in light of the teachings, nor was there a teaching or suggestion of enlarging five to thirty times. Since a Prima Facie case of obviousness has not been made, Applicant respectfully requests withdrawal of the 103(a) rejection.

CONCLUSION

In view of the foregoing, Applicant respectfully requests timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.


If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 04-2223. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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